

REMARKS

This Amendment is submitted in reply to the non-final Office Action dated April 22, 2009. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-754 on the account statement.

Claims 24-44 are pending in this application. Claims 1-23 were previously canceled without prejudice or disclaimer, and Claims 30-43 were previously withdrawn from consideration. In the Office Action, Claims 24 and 44 are rejected under 35 U.S.C. §112. Claims 24-30 and 44 are further rejected under 35 U.S.C. §103. In response, Claims 24-30 and 44 have been amended. The amendments do not add new matter. At least in view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Applicants note that Claims 25-30 have been amended solely for clarification purposes. These amendments do not add new matter. The amendments are supported in the Specification at, for example, page 1, paragraphs 1, 3 and 5-6; page 2, paragraphs 9 and 12; page 3, paragraph 24, lines 2-15; paragraphs 25 and 27-30; Figs. 2-7.

In the Office Action, Claims 24 and 44 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Patent Office asserts that the term “excess quantity. . . sufficient to prevent a coating gap” is a relative term which renders the claims indefinite. See, Office Action, page 2, lines 11-15. In response, Applicants have amended Claims 24 and 44 for clarification purposes to recite “an excess quantity of coating agent compared with that which would be strictly necessary to establish a continuous layer over the inner wall of the wafer.” These amendments do not add new matter. The amendments are supported in the Specification at, for example, page 1, paragraph 2, lines 19-25; paragraph 3, lines 1-7; paragraph 4, lines 1-20; page 3, paragraph 27, lines 8-15. Thus, Applicants respectfully submit that the scope of the phrase “the excess quantity” in Claims 24 and 44 is clear.

The Patent Office further asserts that the phrase “pipette. . . sufficiently small dimensions. . . able to be positioned close to the bottom tip” is a relative term which renders the claims indefinite. See, Office Action, page 2, lines 16-21. In response, Applicants have

amended Claims 24 and 44 to remove the phrase “sufficiently small dimensions to be able to be.” These amendments do not add new matter. The amendments are supported in the Specification at, for example, page 1, paragraph 3, lines 9-11; paragraph 5, lines 3-7; page 2, paragraph 8, lines 22-29; page 3, paragraph 28, lines 1-15; Figs. 2 and 4. As such, Applicants respectfully submit that Claims 24 and 44 are sufficiently clear.

Accordingly, Applicants respectfully request that the rejection of Claims 24 and 44 under 35 U.S.C. §112, second paragraph, be withdrawn.

In the Office Action, Claims 24-30 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,171,367 to Carter et al. (“*Carter*”) in view of U.S. Patent No. 2,670,696 to Covert et al. (“*Covert*”) and further in view of U.S. Patent Publication No. 2005/0098575 A1 to Carhuff et al. (“*Carhuff*”). For at least the reasons set forth below, Applicants respectfully submit that, even if combinable, the cited references fail to disclose each and every element of independent Claims 24 and 44 and Claims 25-30 that depend therefrom.

Independent Claims 24 and 44 recite, in part, a process comprising the steps of: spraying an inner wall of a container with a liquid coating agent that is capable of solidifying rapidly in order to form a coating layer intended, after the food product has been placed in the container, to separate the wafer and the food product, the coating layer being provided in order, subsequently, to be consumed at the same time as the wafer and the food product, the inside of the container being sprayed with an excess quantity of coating agent compared with that which would be strictly necessary to establish a continuous layer over the inner wall of the wafer, the excess quantity being sufficient to prevent a coating-gap zone on the inner wall of the wafer that is to come into contact with the food product; allowing excess liquid coating agent to collect, under gravity, at the bottom tip of the container; removing, prior to the solidification the excess liquid coating agent; recycling the excess coating agent to a supply for spraying the inside of the container, the excess coating agent being removed via a pipette positioned close to the bottom tip of the container, an end of the pipette including at least one suction orifice; and after suction, supplying the orifice with a gaseous flow in order to expel any possible clogging particles that might remain therein.

It is imperative in manufacturing ice-cream filled cornet wafers to maintain the desirable crunchy nature of the wafer by protecting the wafer from contacting the ice cream. See,

Specification, page 1, paragraph 2, lines 1-5. Conventional methods of addressing this problem have simply sprayed an excess amount of chocolate coating agent on the inner wall of the wafer to form a barrier between the wafer and the ice cream. See, Specification, page 1, paragraph 2, lines 5-19. However, although the spraying of excess coating agent prevents a gap forming in the chocolate layer, it results in an excess quantity of chocolate accumulated at the bottom tip of the cone, thereby making the cone undesirable to consumers. See, Specification, page 1, paragraph 2, lines 19-25. Therefore, the present claims provide a method in which the inside of the container is sprayed with an excess quantity of coating agent compared with that which would be strictly necessary to establish a continuous layer over the inner wall of the wafer, and prior to the solidification the excess liquid coating agent is removed via a pipette positioned close to the bottom tip of the container and is recycled for spraying another container. By removing the excess coating agent via a pipette and recycling the excess coating agent to a supply for spraying the inside of another container, the present claims reduce the cost associated with using excess coating agent and eliminate consumer dissatisfaction associated with excess coating agent in the bottom of the cone. See, Specification, page 1, paragraph 3. In contrast, Applicants respectfully submit that the cited references are deficient with respect to the present claims.

For example, even if combinable, the cited references fail to disclose or suggest after suction, supplying the orifice with a gaseous flow in order to expel any possible clogging particles that might remain therein as required, in part, by independent Claims 24 and 44 from which Claims 25-30 depend. The Patent Office admits that both *Carter* and *Covert* fail to disclose “back flushing the nozzle” and instead relies on *Carhuff* for disclosure of expelling particles in the orifice using a gaseous flow. See, Office Action, page 5, lines 1-14; page 6, lines 11-13.

However, Applicants respectfully submit that *Carhuff* is improper prior art because it was commonly owned at the time of the invention. “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” See, M.P.E.P. §2146 (2009).

Carhuff was published on May 12, 2005, after the earliest effective filing date of the present application, but was filed on October 24, 2003, before the filing date of the present application. As such, *Carhuff* qualifies as prior art only under 35 U.S.C. §102(e). However, *Carhuff* and the present application were commonly owned or under an obligation of assignment to Nestec S.A. at the time of the claimed invention. As such, Applicants respectfully submit that *Carhuff* is not proper prior art and, thus, the cited references fail to disclose supplying the orifice with a gaseous flow in order to expel any possible clogging particles that might remain therein in accordance with the present claims.

Moreover, the cited references fail to disclose removing excess coating agent via a pipette as recited, in part, by independent Claims 24 and 44. The Patent Office admits that *Carter* fails to disclose removing excess chocolate and instead relies on *Covert* for disclosure of the claimed element. See, Office Action, page 5, lines 1-9 and 21-22. However, *Covert* merely discloses suction removal of chocolate from a mold using a nozzle. See, *Covert*, column 2, lines 1-10 and 17-19; column 3, lines 1-6. In fact, the portion of *Covert* relied on by the Patent Office states that “[t]he suction is on when the nozzle meets the surface of the liquid in the mold cavity.” See, *Covert*, column 2, lines 1-2. Nowhere does *Covert* disclose or suggest removing the chocolate via a pipette, nor does the Patent Office cite support for such claimed element. Therefore, Applicants respectfully submit that the cited references fail to disclose that the excess coating agent is removed via a pipette as required, in part, by the present claims.

The cited references also fail to disclose the inside of the container being sprayed with an excess quantity of coating agent as recited, in part, by independent Claims 24 and 44. The Patent Office admits that *Carter* fails to disclose an excess quantity of coating agent and instead asserts that *Covert* discloses the use of excess chocolate. See, Office Action, page 5, lines 1-9 and 21-22. However, the portion of *Covert* relied on by the Patent Office merely discloses that molds have been “filled” with chocolate, not that they have been “sprayed” with an excess quantity of chocolate. See, *Covert*, column 1, lines 41-47. When describing its suction removal of chocolate from molds, *Covert* states that “multiple cavity molds 7, which have been previously filled in a depositing machine, are carried by a conveyor 8 into position beneath suction nozzles 9.” See, *Covert*, column 1, lines 42-45. This difference is significant because if the entire ice cream cone were completely filled with liquid chocolate, rather than spraying the chocolate only

on the inner wall of the cone, the ice cream cone would immediately soften and lose its crispiness. Nowhere does *Covert* disclose or even suggest that its molds are “sprayed” with an excess quantity of chocolate, nor does the Patent Office cite support for such claimed element. Thus, Applicants respectfully submit that the cited references fail to disclose the inside of the container being sprayed with an excess quantity of coating agent as required, in part, by the present claims.

Furthermore, one of ordinary skill in the art would have no reason to combine *Carter* and *Covert* because they are directed to different problems in different fields of endeavor. *Carter* is entirely directed to spraying a chocolate coating on the interior of an ice cream cone immediately before the cone is filled with ice cream. See, *Carter*, column 1, lines 56-60; column 2, lines 5-7. *Carter* teaches that “saving of the chocolate coating material is effected because it is not necessary to provide a large quantity in accordance with the method of the present invention since sufficient time is not permitted for the absorption of an unnecessary and excessive amount of chocolate into the pores of the cones.” See, *Carter*, column 2, lines 17-22. Therefore, it is apparent that no excess chocolate is generated in the ice cream cone production process of *Carter* and *Carter* is completely unconcerned with the removal of excess chocolate in the bottom of its cone.

In contrast, *Covert* is entirely directed to suction removal of an excess quantity of chocolate in a mold during the manufacture of chocolate shells for filled candies. See, *Covert*, column 1, lines 1-13. *Covert* states that “it is a purpose of the invention to eliminate the need for inverting the molds to pour off excess chocolate and then to scrape the mold faces clear of spilled chocolate.” See, *Covert*, column 1, lines 6-9. Because *Covert* involves the manufacture of filled candy chocolate shells in molds, *Covert* is entirely unconcerned with the problems related to an excess quantity of chocolate in a consumable ice cream cone. As such, one of ordinary skill in the art would have no reason to combine the ice cream cone manufacturing process steps of *Carter* with the suction removal step of *Covert* to arrive at the present claims.

Accordingly, Applicants respectfully request that the rejection of Claims 24-30 and 44 under 35 U.S.C. §103(a) to *Carter*, *Covert* and *Carhuff* be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly request an early allowance of the same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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